

Applic. No.: 09/658,712
Amdt. Dated May 31, 2006
Reply to Office action of April 14, 2006

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-3, 5-6, 9-14, and 17-22 remain in the application.

Claims 1 and 10 have been amended. Claims 4, 7-8, and 15-16 have been cancelled.

In the second paragraph on page 2 of the above-mentioned Office action, claims 1, 5, and 10 have been rejected as being anticipated by Shiba et al. (US 5,429,046)) under 35 U.S.C. § 102(b).

In the second paragraph on page 3 of the above-mentioned Office action, claims 3 and 10 have been rejected as being unpatentable over Shiba et al. in view of Guaraldi et al. (US 5,027,705) under 35 U.S.C. § 103(a).

In the penultimate paragraph on page 3 of the above-mentioned Office action, claims 2 and 11-14 have been rejected as being unpatentable over Shiba et al. in view of Fischer (US 4,148,256) under 35 U.S.C. § 103(a).

In the third paragraph on page 4 of the above-mentioned Office action, claims 7-8 have been rejected as being unpatentable

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over Shiba et al. in view of Buchwald (US 5,813,961) under 35 U.S.C. § 103(a).

In the second paragraph on page 5 of the above-mentioned Office action, claims 6, 9, 17-18, and 20-21 have been rejected as being unpatentable over Shiba et al. in view of Klingler et al. (US 4,361,090) under 35 U.S.C. § 103(a).

In the penultimate paragraph on page 6 of the above-mentioned Office action, claims 19 and 22 have been rejected as being unpatentable over Shiba et al. in view of Klingler et al. and further in view of Fischer under 35 U.S.C. § 103(a).

The rejections have been noted and claims 1 and 10 have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found in original claims 7-8.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 10 call for, inter alia:

a circumferential surface provided with a surface structure and formed of a nonmetallic material, said circumferential surface carrying a liquid and being a roller selected from the group of rollers consisting of a slip roller and a ductor roller, said surface structure

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being irregularly structured, said surface structure being formed of slats, and an arithmetical average height of the surface structure, determined by the slats, being at least 12 microns.

Claim 17 calls for, inter alia:

a circumferential surface being formed of a nonmetallic material and having a surface structure selected from one of the group consisting of:

a multiplicity of dimples formed in the circumferential surface; and

slats providing the surface structure with an arithmetical average height of at least 12 microns.

Claim 20 calls for, inter alia:

the surface structure being one of the group consisting of:

a multiplicity of dimples formed in the circumferential surface; and

slats providing the surface structure with an arithmetical average height of at least 12 microns.

The features of original claims 7 and 8 have been incorporated into amended claims 1 and 10 of the instant application. The Examiner has rejected claim 7 and thus also claim 8 using Buchwald. Buchwald mentions a helix or spiral (see column 3, line 16), which is obviously regular. This would lead a person skilled in the art away from the subject matter of claims 7-8 of the instant application.

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It is noted that a helix-shaped structure was originally recited in claim 4, which has been cancelled in the response dated August 17, 2004. Therefore, the helix-shaped structure is no longer the subject matter of the invention of the instant application.

Applicants do not agree with the Examiner's opinion that the helix structure in Buchwald has slats. Slats and a helix-shaped structure are totally different things.

Applicants also do not agree with the Examiner's opinion that the feature of claim 8 is an obvious design choice for a person skilled in the art. The Examiner's opinion is believed to be hindsight without reasoning and support.

Claims 17 and 20 have been rejected as unpatentable over Shiba et al. in view of Klingler et al. It is noted that the Examiner has overlooked the fact that Klingler et al. state in column 1, lines 35-36 that such a surface structure causes difficulties. This would lead a person skilled in the art away from the subject matter of claims 17 and 20 of the instant application.

The Examiner has stated in the section "Response to Arguments" on page 7 of the Office action that Guaraldi et al. disclose a

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slip roller. However, the Examiner has not taken into account the fact that the slip roller 16 has a conventional circumferential surface (see column 3, lines 52-53). A person skilled in the art would know that the conventional circumferential surfaces are smooth and thus unstructured. Also, Figs. 1-4 of Guaraldi et al. clearly show the smooth circumferential surface of the slip roller 16. This would lead a person skilled in the art away from the subject matter of the invention of the instant application. The subject matter of the invention of the instant application is that the roller has a circumferential surface structure.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 10, 17, and 20. Claims 1, 10, 17, and 20 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 17, or 20, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-3, 5-6, 9-14, and 17-22 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call

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so that, if possible, patentable language can be worked out.
In the alternative, the entry of the amendment is requested as
it is believed to place the application in better condition
for appeal, without requiring extension of the field of
search.

If an extension of time for this paper is required, petition
for extension is herewith made. Please charge any fees which
might be due with respect to 37 CFR Sections 1.16 and 1.17 to
the Deposit Account of Lerner Greenberg Sterner LLP, No. 12-
1099.

Respectfully submitted,

For Applicants

YC

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